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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,476	02/16/2004	John I. M. Choate		1542

7590 10/13/2006

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/780,476	<b>Applicant(s)</b> CHOATE, JOHN I. M.	
	<b>Examiner</b> Jeffrey G. Hoekstra	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on n/a is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II, drawn to claims 4-12, in the reply filed on 09/05/2006 is acknowledged.
2. Claims 1-3 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/05/2006.

### ***Drawings***

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology

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often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because excessive length (e.g. > 150 words). Correction is required. See MPEP § 608.01(b).

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method of reducing inflammation associated with a tactile deficit of finger sensation

### ***Claim Objections***

7. Claim 4 is objected to because of the following informalities: the conjunction "and" appears to be missing before method step "Z". Appropriate correction is required.

8. Claim 5 is objected to because of the following informalities: the conjunction "and" appears to be missing before the positive recitation of "distal sensory latency test". Appropriate correction is required.

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9. Claim 6 is objected to because of the following informalities: the positive recitation of "or any equipment" appears to be render the claim indefinite. Appropriate correction is required.

10. Claim 9 is objected to because of the following informalities: the conjunction "and" appears to be missing before the positive recitation of "the volar (aka palmar) interossei muscles". Appropriate correction is required.

11. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

12. The examiner notes claims 12-14 appear to be missing and/or the numbering of claim 15 was a typographical error

Misnumbered claim 15 has been renumbered 12.

### ***Claim Rejections - 35 USC § 112***

13. Claim 6 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and *functional* or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

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manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

***Claim Rejections - 35 USC § 101***

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 positively claims natural phenomenon, such as "the nine flexor tendons next to the median nerve".

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 4-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Choate (US 6,692,435 B1).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

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either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

18. For claim 4, Choate discloses (column 10 line 12 – column 15 line 26) a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, the method comprising the steps of: A) identifying the subject's nerve pathology by diagnostic tests; B) identifying the subject's base line physical condition by inspection or examination tests; C) conducting the base line physical condition tests; D) providing the subject a tool; E) selecting exercises as uses of the tool to maximize inflammation in the structures adjacent to the nerve; F) instructing the subject on a use of the tool to maximize inflammation in the structures adjacent to the nerve; G) instructing the subject on self reporting of pain, tingling, decrease or change of feeling; H) instructing the subject to perform the self reporting; I) the subject performs the self reporting; J) instructing the subject on exercises of the tool to maximize inflammation; K) instructing the subject to perform the exercise of the tool to maximize inflammation; L) the subject performs the exercise; M) repeat steps C, H and I; N) adjourning the testing while awaiting the return of the subject to the base line physical conditions in step B; O) selecting exercises as uses of the tool to minimize inflammation in the structures adjacent to the nerve; P) repeat steps C, H and I; Q) instructing the subject on a use of the tool to minimize inflammation in the structures adjacent to the nerve; R) instructing the subject to perform the exercise of the tool to minimize inflammation; S) the subject performs the exercise; T) repeat steps C,

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H and I; U) identify number of tests to conduct to obtain statistically reliable and reproducible results; V) identify number of subjects to test to obtain statistically reliable and reproducible results; W) alternate between steps E to M and O to T to blind the results; X) conduct, preserve, protect and record all steps as necessary with sufficient tests, subjects, and alternates to obtain meaningful data; Y) establish end points for the data; and Z) calculate the statistical deviations necessary to compare the end points tools.

19. For claim 5, Choate discloses a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, wherein the diagnostic test is Tinel's sign (column 12 lines 20-39).

20. For claim 6, Choate discloses a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, wherein the exercises and use of the tool, includes decreasing inflammation via typing on the AsInRedHot, Dvorak, keyboard or any efficient keyboard with the letter E on the home row (column 12 lines 20-39).

21. For claim 7, Choate discloses a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, wherein the nerve pathology is median nerve entrapment, ulnar nerve entrapment, or any neuropathy or neuritis (column 11 lines 25-29).

22. For claim 9, Choate discloses a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, wherein the work of any or all of the nine flexor muscles next to the



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median nerve is shifted to the lumbricals of the fingers , the dorsal interossei of the hand, the volar (aka palmar) interossei muscles (column 11 lines 43-52).

23. For claim 10, Choate discloses a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, wherein the base line physical condition by inspection or examination tests includes caliper or tape measure of hand volume (column 12 lines 20-39).

24. For claims 11 and 12, Choate discloses a method for testing and preventing the onset of symptoms of nerve pathology, improving discovery of cancer mass and reducing inflammation, wherein (a) the baseline physical condition assessment includes nutrition (column 15 lines 9-18) and (b) the step of the patient selecting for treatment of symptoms of physical disability includes swelling (column 12 lines 20-39).

### ***Conclusion***

25. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent

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Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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